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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,491	04/12/2004	John W. Swanson	MH1.238	3021

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EXAMINER

COHEN, LEE S

ART UNIT PAPER NUMBER

3739

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/822,491

Applicant(s)

SWANSON, JOHN W.

Examiner

Lee S. Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). In claims 4-8, references to flexible polymer substrate and the conductive material are vague since such limitations have not been previously presented.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, and 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Humphrey (6,171,239). Applicant's attention is directed to the Figure 2B and 2C embodiment as detailed at column 8, line 49+. In light of the discussion relating to the Figure 2A embodiment at column 8, lines 9-26, the particular dimensions are deemed to be inherent in the Figure 2A and B embodiment.

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Claims 1, 2, 6, and 8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Edell et al (2002/0198582). Applicant's attention is directed to figure 8 and paragraphs [0044] to [0046].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuperstein (4,461,304) in view of Humphrey (6,171,239). The basic brain probe is disclosed by Kuperstein (see Figures 4-6 and the accompanying description). The reference discloses a length of 2mm for the active recording area (column 3, lines 64-65). Overall lengths of greater than 5mm are disclosed by Humphrey at column 8, lines 17-18. Given this teaching, it would have been obvious to form the Kuperstein device with the claimed length to effect recording/stimulation at varying depths.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Humphrey (6,171,239), Edell et al (2002/0198582), or Kuperstein (4,461,304) in view of Humphrey (6,171,239) as applied to claim 1 above, and further in view of Lynch et al (5,038,781). The particular material for the polymer is not disclosed by the references. Lynch et al shows the use of polyether sulfone at column 8, line 23 for a probe base. Accordingly, the use of the same in any of the references would have been obvious to the skilled artisan since it is merely a design expedient not affecting performance of the device.

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Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humphrey (6,171,239), Edell et al (2002/0198582), or Kuperstein (4,461,304) in view of Humphrey (6,171,239) as applied to claim1 above, and further in view of Hofmann et al (6,330,466). The particular materials for the polymer and conductors are not disclosed by the references. Hofmann et al shows the use of polyimide and conductive polymer at column 3, lines 23-37 for a probe. Accordingly, the use of the same in any of the references would have been obvious to the skilled artisan since they are merely design expedients not affecting performance of the device.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Humphrey (6,171,239) or Kuperstein (4,461,304) in view of Humphrey (6,171,239) as applied to claim1 above, and further in view of Edell et al (2002/0198582). The particular material for the polymer is not disclosed by the references. Edell et al shows the use of liquid crystal polymer at for a probe base. Accordingly, the use of the same in any of the references would have been obvious to the skilled artisan since it is merely a design expedient not affecting performance of the device.

#### ***Allowable Subject Matter***

Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Specification***

The disclosure is objected to because of the following informalities: page 9, line is vague.

Appropriate correction is required.

### ***Drawings***

The drawings are objected to because numeral 72 has been omitted. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Conclusion***

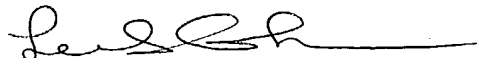
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art discloses similar probes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee S. Cohen whose telephone number is 571-272-4763. The examiner can normally be reached on Monday-Friday, 7:00-3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lee S. Cohen  
Primary Examiner  
Art Unit 3739

LSC  
November 17, 2004